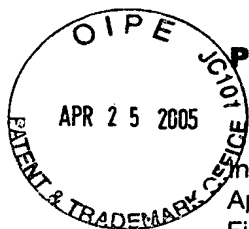


AF
HPWPractitioner's Docket No. K-1775D**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**In re application of: Montgomery, Jr.Application No.: 10 / 657,397 Group No.: 3673Filed: September 8, 2003 Examiner: Singh, SunilFor: MANUALLY REPLACEABLE PROTECTIVE WEAR SLEEVE**Mail Stop Appeal Brief—Patents****Commissioner for Patents****P.O. Box 1450****Alexandria, VA 22313-1450****TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION—37 C.F.R. § 41.37)**

NOTE: The phrase "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) (which provides an adjustment of patent term if there is a delay on the part of the Office to respond within 4 months after an "appeal was taken") means the date on which an appeal brief under § 1.192 (and not a notice of appeal) was filed. Compliance with § 41.37 requires that: 1. the appeal brief fee (§ 41.20(b)(2)) be paid (§ 41.37(a)(2)); and 2. the appeal brief complies with §§ 41.73(c)(i)-(x). See Notice of September 18, 2000, 65 Fed. Reg. 56366, 56385-56387 (Comment 38).

1. Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on February 22, 2005

NOTE: Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31. 37 CFR 41.(a)(1). The brief is no longer required in triplicate. The former alternative time for filing a brief (within the time allowed for reply to the action from which the appeal was taken) has been removed. Appellant must file within two months from the notice of appeal. See Notice of August 12, 2004, 69 FR 49960, 49962.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is **mandatory**;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

☒ deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 C.F.R. § 1.8(a)**37 C.F.R. § 1.10 ***

☒ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"

Mailing Label No. _____ (mandatory)

TRANSMISSION

☐ facsimile transmitted to the Patent and Trademark Office, (703) _____

Signature 

Date: April 22, 2005

Rhonda L. Sanders

(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

2. STATUS OF APPLICANT

This application is on behalf of

☒ other than a small entity.

☐ a small entity.

A statement:

☐ is attached.

☐ was already filed.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ small entity \$250.00

☒ other than a small entity \$500.00

Appeal Brief fee due \$ 500.00

4. EXTENSION OF TERM

NOTE: 37 C.F.R. § 1.704(b) ". . . an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

NOTE: The time periods set forth in 37 C.F.R. § 1.192(a) are subject to the provision of § 1.136 for patent applications. 37 C.F.R. § 1.191(d). See also Notice of November 5, 1985 (1060 O.G. 27).

NOTE: As the two-month period set in § 1.192(a) for filing an appeal brief is not subject to the six-month maximum period specified in 35 U.S.C. § 133, the period for filing an appeal brief may be extended up to seven months. 62 Fed. Reg. 53,131, at 53,156; 1203 O.G. 63, at 84 (Oct. 10, 1997).

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

(complete (a) or (b), as applicable)

- (a) ☐ Applicant petitions for an extension of time under 37 C.F.R. § 1.136 (fees: 37 C.F.R. § 1.17(a)(1)-(5)) for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/> one month	\$ 120.00	\$ 60.00
<input type="checkbox"/> two months	\$ 450.00	\$ 225.00
<input type="checkbox"/> three months	\$ 1,020.00	\$ 510.00
<input type="checkbox"/> four months	\$ 1,590.00	\$ 795.00
<input type="checkbox"/> five months	\$ 2,160.00	\$ 1,080.00

Fee: \$ _____

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If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

- ☐ An extension for _____ months has already been secured, and the fee paid therefor of \$ _____ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ _____

or

- (b) ☒ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee \$ 500.00

Extension fee (if any) \$ _____

TOTAL FEE DUE \$ 500.00

6. FEE PAYMENT

- ☒ Attached is a ☒ check ☐ money order in the amount of \$ 500.00
- ☐ Authorization is hereby made to charge the amount of \$ _____
- ☐ to Deposit Account No. _____
- ☐ to Credit card as shown on the attached credit card information authorization form PTO-2038.

WARNING: Credit card information should **not** be included on this form as it may become public.

- ☒ Charge any additional fees required by this paper or credit any overpayment ~~in the manner authorized above.~~ to Deposit Account No. 02-2267

- ☒ A duplicate of this paper is attached.

7. FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to change the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

- ☒ If any additional extension and/or fee is required,

AND/OR

- ☒ If any additional fee for claims is required, charge:

☒ Deposit Account No. 02-2267

- ☐ Credit card as shown on the attached credit card information authorization form PTO-2038.

WARNING: Credit card information should **not** be included on this form as it may become public.

Date: April 22, 2005

Reg. No.: 28,688

Customer No.: 1400



SIGNATURE OF PRACTITIONER

Stephen T. Belsheim
(type or print name of practitioner)

179 Belle Forrest Cr. Ste. 102
P.O. Address

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of: Montgomery, Jr.
Serial No. 10/657,397
Filed: September 8, 2003
For: MANUALLY REPLACEABLE
PROTECTIVE WEAR SLEEVE

)
) GROUP ART UNIT 3673
)
) Examiner: Singh, Sunil

Mail Stop Appeal Brief – Patents
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

Certificate of Mailing (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to Mail Stop –Appeal Brief Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22131-1450.

Date: APRIL 22, 2005

Signature: 
Rhonda L. Sanders

Type or Print Name of Person Certifying

Sir: **APPEAL BRIEF UNDER 37 CFR §41.37**

INTRODUCTION

This Appeal Brief is being filed within two (2) months of the filing of the Notice of Appeal on February 22, 2005. The appropriate fee accompanies this paper per the accompanying TRANSMITTAL OF APPEAL BRIEF.

REAL PARTY IN INTEREST

To satisfy the requirement under 37 CFR §41.37(c)(1)(i), Kennametal Inc. of Latrobe, Pennsylvania 15650, the assignee of the present patent application, is the real party in interest.

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RELATED APPEALS AND INTERFERENCES

To satisfy the requirement under 37 CFR §41.37(c)(1)(ii), there are no related appeals and interferences.

STATUS OF THE CLAIMS

To satisfy the requirement under 37 CFR §41.37(c)(1)(iii), the status of the claims in the patent application is set forth as follows: (a) claims 1-21 are cancelled, and (b) claims 22-25 are rejected and are under appeal.

STATUS OF AMENDMENTS

To satisfy the requirement under 37 CFR §41.37(c)(1)(iv), there are no amendments that have been filed subsequent to the final rejection.

SUMMARY OF THE CLAIMED SUBJECT MATTER

To satisfy the requirement under 37 CFR §41.37(c)(1)(v), a summary of claimed subject matter is set forth below. The only independent claim under appeal is claim 22 so that a concise explanation of claim 22 is presented below.

The invention is a protective wear sleeve (14) for use with a bit holder (12) of a cutting tool assembly wherein the bit holder (12) contains a central bore (24). See page 6, lines 5-10. The wear sleeve (14) includes an elongate body that has an axial forward end and an axial rearward end. The elongate body further has a solid enlarged diameter portion (34) adjacent to the axial forward end thereof and a split portion (30) beginning at and extending in an axial forward direction from the rearward end wherein the split portion (30) contains a slot so that the split portion (30) is flexible in a radial direction. The elongate body also has a solid intermediate portion (32) that is between and contiguous with the enlarged diameter portion (34) and the split portion (30). The split portion (30) has an external surface that is uniform over the entire length thereof. The intermediate portion (32) has an external surface that is uniform wherein the diameter of the external surface of the split portion (30) is equal to the diameter of the surface of the intermediate portion (32). Referring to page 7, lines 13-23, when the wear sleeve (14) is in the central bore (24), the external surface of the split portion (30) is biased in a radial outward direction against the central bore (24) of the bit holder (12) so as to retain the wear sleeve (14) in the central bore (24) of the bit holder (12).

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GROUND OF REJECTION TO BE REVIEWED ON APPEAL

To satisfy the requirement under 37 CFR §41.37(c)(1)(vi), a concise statement of the grounds for rejection to be reviewed on appeal are as follows:

claims 22-25 stand rejected as being anticipated under 35 USC §102(b) by U.S. Patent No. 5,683,143 to Peterson et al. patent.

ARGUMENT

Introduction

To satisfy the requirement under 37 CFR §41.37(c)(1)(vii), the argument is set forth below.

Discussion

By the final Office Action from which this appeal has been taken, the patent examiner has presented one rejection; namely, claims 22-25 have been rejected as being anticipated by the Peterson et al. patent. Appellant respectfully disagrees with this rejection for the reasons set out hereinafter. Appellant urges the Board to reverse this rejection and remand the application to patent examiner with instructions to allow the claims.

Peterson et al. pertains to a device that is used to treat floor surfaces and the patent examiner focuses on the sleeve (35) of Peterson et al. as being the anticipatory disclosure in the document.

The first point to consider is that Peterson et al. pertains to technical subject matter different from that of claims 22-25. More specifically, Peterson et al. pertains to a device used to treat floors and not a, "... protective wear sleeve for a bit holder of a cutting tool assembly wherein the bit holder contains a central bore ..." as recited in claim 22. The preamble recitation in claim 22 gives life and meaning to the claim in light of the later recitation that, "... when the wear sleeve is in the central bore, the external surface of the split portion is biased in a radial outward direction against the central bore of the bit holder so as to retain the wear sleeve in the central bore of the bit holder." For this reason alone the Board should reverse the rejection.

A second point to consider is the compelling difference between the sleeve (35) of Peterson et al. and the present invention as claimed in claim 22 because the Peterson et al. sleeve (35) does not satisfy the above-mentioned recitation that the external surface of the split

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portion "is biased in a radial outward direction" when the wear sleeve is in the central bore of the bit holder.

The Peterson et al. sleeve (35) receives a pin (41) that has an enlarged head (43) with an abrasive surface. The pin (41) includes a hole (49) that receives a roll pin (47) whereby the roll pin (47) passes through a slot (51) in the sleeve (35) to engage the hole (49). There is no mention in Peterson et al. about the sleeve having any structure or function wherein the sleeve extends in a radial outward fashion. See Column 3, lines 65 through Column 4, line 11 of Peterson et al.

Appellant thus respectfully submits that Peterson et al. cannot anticipate claim 22, as well as the claims that depend from claim 22; namely, claims 23-25.

Conclusion

Appellant submits that claims 22-25 are patentable over Peterson et al.
Appellant solicits the reversal of this rejection and a remand to the patent examiner with instructions to allow the claims.

Respectfully submitted,

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CLAIM APPENDIX PER 37 CFR §41.37(c)(1)(viii)

The claims under appeal are set forth below:

22. A protective wear sleeve for a bit holder of a cutting tool assembly wherein the bit holder contains a central bore, and the wear sleeve comprises:
an elongate body having an axial forward end and an axial rearward end;
the elongate body having a solid enlarged diameter portion adjacent to the axial forward end thereof and a split portion beginning at and extending in an axial forward direction from the rearward end wherein the split portion contains a slot so that the split portion is flexible in a radial direction, and a solid intermediate portion being between and contiguous with the enlarged diameter portion and the split portion;

the split portion having an external surface that is uniform over the entire length thereof, and the intermediate portion having an external surface that is uniform wherein the diameter of the external surface of the split portion is equal to the diameter of the surface of the intermediate portion; and

when the wear sleeve is in the central bore, the external surface of the split portion is biased in a radial outward direction against the central bore of the bit holder so as to retain the wear sleeve in the central bore of the bit holder.

23. The protective wear sleeve of claim 22 wherein the split portion extends for less than one-half of the axial length of the elongate body.

24. The protective wear sleeve of claim 22 wherein the enlarged diameter portion comprises a collar for protecting the bit holder from axial forces applied to the cutting tool.

25. The protective wear sleeve of claim 22 wherein the elongate body has a generally cylindrical geometry.

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EVIDENCE APPENDIX UNDER 37 CFR §41.37(c)(1)(ix)

There is no evidence under Sections 1.130, 1.13 0 or 1.132 that appellant intends to rely upon in this appeal.

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RELATED PROCEEDINGS APPENDIX UNDER 37 CFR §41.37(c)(1)(x)

There are no related proceedings.